

REMARKS

Claims 1-3, 5-11 and 13-17 are currently pending. Upon entry of the above amendment, claim 1 shall be amended to correct a minor typographical error. It is respectfully submitted that this amendment of claim 1 is proper for entry after final rejection inasmuch as it simplifies the issues for appeal and does not present any new issues that would require further consideration or search. Accordingly, claims 1-3, 5-11 and 13-17 shall be pending upon entry of the foregoing amendment.

Applicants respectfully request reconsideration and withdrawal of the rejections of the claims.

In the final Office Action, the Examiner maintained the rejection of claims 1-3 under 35 U.S.C. § 103, as allegedly being unpatentable over the Hamada patent in view of the Toyofuku patent, the rejection of claims 5, 6 and 14 under Section 103, as allegedly being unpatentable over Toyofuku patent in view of Hamada et al., and a rejection of claim 10 under Section 103, as allegedly being obvious over Toyofuku in view of the Isoguchi et al. patent. The final Office Action states that the arguments presented by Applicants in the Amendment filed September 15, 2003, were not considered to be persuasive, for the following reasons:

In the "Response to Arguments" section of the final Office Action, the Examiner acknowledges that the Hamada patent does not disclose moving a lens to an in-focus state and asserts that Hamada teaches to move a lens to a frequently used focal length upon power-up of the camera. Next, the Examiner alleges "[t]his insinuates that the camera is tracking focal lengths of each of the images taken by the user, and driving the lens to a position that is very close to an in-focus position." (See the final Office Action, page 2, section 3, lines 11-12.) It is respectfully submitted, however, that the claim 5 does not merely recite "a position that is very close to an in-focus position," as alleged in the Office Action. Rather, claim 5 recites, among other features, that "an in-focus condition is substantially obtained for distant to close-range views" Applicants respectively reiterate that the Hamada patent does not teach or suggest this claimed feature.

The Hamada patent is concerned with problems encountered with cameras that automatically drive a variable focus lens device to a position of shortest focal length (i.e., a telephotographing position) when the camera is first turned on (i.e., powered-up). According

to Hamada, when photographing objects in the telephotographing lens position just after turning on a camera, a scene surrounding an object desired to be in the photograph may be cropped from the composition because of the narrow field associated with this lens position. Additionally, Hamada discloses that an instantaneous change of a moving object cannot be quickly photographed while the lens moves from the initial position through to the photographing position. The Hamada patent attempts to address these problems by automatically moving the lens to a position having a focal length that might be closer to a desired focal length that would be set when photographing an object. As a result, Hamada discloses that the camera can adjust the lens at a desired width of field for photographing more quickly, without confusing the user during photographing. (See column 1, lines 33-47.) More particularly, Hamada describes that when the power switch of the camera is turned on, a variable focus lens device is automatically set either to a position corresponding to a focal length intermediate the telephotographing and wide angle lens positions of the lens barrel, to a position of focal length corresponding to a "standard angle of view" (i.e., 46 degrees), to a field of view corresponding to a particular film type used, or to a frequently used focal length position. (See column 2, lines 1-62.)

In contrast, claim 5 is directed to a camera having a controller for driving a taking lens *to a focus position where in-focus condition is substantially obtained for distant to close-range views* before display by a display device is started. It is respectfully submitted that the Hamada patent does not disclose teach or suggest features, as was pointed out on page 10 of Applicants' September 15, 2003 response:

Hamada does not teach focusing by way of such lens movement. In other words, *Hamada* simply teaches how to control the focal length of a zoom lens when the main switch of a silver-halide-film camera is turned on. (See column 4, lines 40-46; column 7, lines 23-27; and column 8, lines 11-18.) (Emphasis in original.)

The response goes on to point out that the claimed "in-focus condition" concerns moving a lens to a position of focus adjustment, where the lens is focused on a subject at a particular distance. This distance recited in claim 5 is "*distant to close-range*." The final Office Action, however, does not address these recited features missing from the Hamada patent.

The Office Action also states that the Hamada patent discloses moving a focus lens to a "usable position" upon power-up of an entire camera system. However, the extent that the

Hamada et al. describes that an initial lens position is usable appears to only concern proximity of the lens at the initial position to a desired position (and corresponding width of field) obtained when composing a photograph. (See column 4, lines 32-39.) Moreover, it would appear that a user of the Hamada et al. camera might be required to make some adjustment to obtain a desired focal length position, and further that the lens is either manually automatically focused on something within the scene being photographed. That is, the Hamada et al. patent does not appear to suggest that a photograph is immediately taken at the initial focal length position, and more importantly, does not suggest the claimed feature of a controller operative for driving the taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range views before display by the display device is started, wherein said driving of the taking lens is performed when power supply to the camera is started.”

On page 3, line 1 of final Office Action, the Examiner states “Toyofuku is used to show the limitation of driving a lens to an in-focus state. It is respectfully submitted that the description in the Toyofuku patent relied upon for showing a lens that is driven to an in-focus state does not pertain to the combination of claimed features including a lens that is driven to a focus position where in-focus condition is substantially obtained for distant to close-range views when power supply to the camera is started. To the contrary, the in-focus position described in the Toyofuku patent relates to an in-focus state obtained only after pressing and holding the LCD switch 58 in a state in which the camera is already powered-up. Moreover, Toyofuku discloses that when the camera is started, the lens is reset to a reset position. (See column 7, lines 39-42, column 15, lines 49-51 and Figures 12 and 24.) Hence, the Toyofuku patent likewise does not teach or suggest a controller for moving a lens to an in-focus position for *distant to close-range views* when power supply to the camera is started, as claimed.

Despite the deficiencies noted above for the Hamada et al. and Toyofuku patents, page 3, lines 1-4 of the Office Action includes that following conclusory statements regarding the obviousness of the missing features:

By driving the lens to an in-focus position upon power-up, the camera is ready to take pictures immediately. Additionally, it would have been obvious to move the lens to an in-focus position upon startup so that, if requested, an image can be displayed as soon as the camera is powered up.

It is respectfully submitted that these statements are neither based in any factual evidence from the applied references nor from knowledge generally available to one of ordinary skill in the art. As such, Applicants submit that one of ordinary skill in the art would not have been led to modify the Toyofuku camera as suggested by the Examiner because there is no teaching or suggestion in the Toyofuku and Hamada et al. documents for doing so. More particularly, there is no suggestion in Toyofuku and Hamada et al. of driving the lens to an in-focus position upon power-up, much less the claimed combination of specific features including "a controller operative for driving the taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range views before display by the display device is started, wherein said driving of the taking lens is performed when power supply to the camera is started."

In view of this, Applicants respectfully submit that the motivation provided to modify the cited reference is based on knowledge gained only after having viewed Applicants' own disclosure. However, MPEP § 2141 instructs: "the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." Additionally, MPEP § 2143 sets forth that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 1438 (Fed. Cir. 1991)." The Federal Circuit has clearly held that "the motivation to combine references cannot come from the invention itself." *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 30 USPQ.2d 1377 (Fed. Cir. 1993).

For at least these reasons, the Office has failed to establish a *prima facie* case of obviousness. The rejection of claim 5 is therefore improper and should be withdrawn.

Claims 6-9 depend from claim 5 and are therefore allowable for the above reasons, and further for the additional features recited. For example, claim 7 recites that the controller is further configured to drive the taking lens to the focus position *after* driving of the display is started. The Examiner alleges that the Toyofuku patent discloses this claimed feature because the pressing of the LCD switch 58 starts the driving of the display. (See the Office Action, page 6, section 17.) This interpretation by the Examiner, however, appears inconsistent with his interpretation of how the Toyofuku patent allegedly teaches the features

of claim 6, which recites “the controller starts driving of the display device *after* performing the driving of the taking lens.” Furthermore, the Toyofuku patent does not appear to disclose any particulars concerning when *driving* of the LCD is started. Because the Examiner’s interpretation of these claims appear contradictory, and because Toyofuku does not appear to teach or suggest *when* driving of the LCD is started, it is respectfully requested that the Examiner provide further clarification as to where these features are allegedly taught in the Toyofuku patent (i.e., the part(s) in Toyofuku in which it is disclosed that driving of the LCD 57 begins to occur). Absent such showing, it is respectfully submitted that the rejection of claims 6 and 7 should be withdrawn.

It is respectfully submitted that distinctions similar to those recited in claim 5 are recited in each of claims 1, 14 and 16. For instance, claim 1 recites “a controller for driving the taking lens to a focus position where *in-focus condition is substantially obtained for distant to close-range views when the camera starts to operate.*” Claim 14 recites “a controller for controlling image taking so that *in-focus condition is substantially obtained for distant to close-range views* before display by the display device is started, wherein said controlling is performed *when power supply to a camera including the camera body is started.*” Claim 16 is directed to a method that includes the steps of “determining whether display of an image captured is requested or not *when power supply to the camera is started*” and “when the display is requested, *driving a taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range views.*” For at least the reasons given above, it is respectfully submitted that the Toyofuku and Hamada patents fail to teach or suggest the claimed combinations of features recited in claims 1, 14 and 16, regardless of whether these documents are considered individually or in any combination.

Dependent claims 2, 3, 13 and 15 each depend from one of claims 1 and 14 and are therefore allowable for the above reasons, and for the additional features recited. It is additionally noted that the rejection of claims 2 and 15 are not clear for reasons similar to those pointed out above for claims 6 and 7. For instance, claim 2 recites “the controller starts driving of the display device after performing said driving of the taking lens,” and claim 15 recites “a controller controls image taking so that said in-focus condition is substantially obtained after driving of the display device has been started.” The Examiner’s interpretation of subject matter described in Toyofuku used to reject claim 2 in one instance, and to reject

claim 15 in another (i.e., the description in Toyofuku of depressing the LCD switch 58), appears contradictory. Hence, the Examiner's interpretation of Toyofuku is inconsistent and, at best, speculative with respect to features set forth in each of claims 2 and 15. As such, it is respectfully submitted that the Toyofuku fails to teach the additional recited features of claims 2 and 15.

With respect to the Section 103 rejection of claim 10¹ based on the Toyofuku and Isoguchi et al. patents, the Examiner did not find the arguments set forth in page 12 of Applicants' response convincing, for the following reasons:

While it is agreed that the lens is driven to infinity after a recording operation, Isoguchi does disclose moving the lens to an initial position after recording an image. Toyofuku teaches moving the lens to an in-focus position so that an image can be displayed properly. Therefore, it would have been obvious to one of ordinary skill in the art to move the lens of Toyofuku to the in-focus position after recording an image so that a camera is quickly reset and capable of capturing another image.

(See the final Office Action, page 3, section 6.) Applicants submit that the stated conclusion reached by the Examiner is not based on any teaching or suggestion from the applied references. Before proceeding with an analysis of these statements, it should be noted that the Examiner's characterization of the claimed *in-focus condition being substantially obtained for distant to close-range views* simply as an "in-focus condition" does not appreciate all the claimed features. It is further submitted that these claimed features are not taught or suggested by the "initial position" of Isoguchi et al. noted in the Office Action. In any event, Applicants submit that the conclusion of obviousness reached by the Examiner amounts to a *non sequitur* because neither Toyofuku patent nor the Isoguchi et al. patent teach, or even remotely suggest, the combination of claimed features that include a controller for driving the taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range views *immediately* after recording of an image is performed.

First, the LCD display 57 of Toyofuku's camera operates in the recording mode to display a through image *only* while the LCD switch 58 is pressed and manually held in this position. As disclosed in Toyofuku, by so handling the LCD switch, power is saved because

the LCD monitor 57 (requiring relatively large power) can remain off when it is unnecessary. (See column 16, lines 1-4.) Hence, this manual operation described in Toyofuku does not teach or suggest the claimed features which include a controller for driving the taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range views *immediately* after recording of an image is performed. In fact, the specific disclosure in Toyofuku of manually operating an LCD switch for purposes of saving power appears to *teach away* from any automatic operation involving a camera lens that is driven into the in-focus position immediately after recording an image.

Second, even if one were to consider, for the sake of argument, that one of ordinary skill in the art would have been motivated to somehow combine the teachings of the Toyofuku and Isoguchi et al. patents, such hypothetical combination would not have taught or suggested all the features recited in claim 10. In contrast, a combination of Toyofuku and Isoguchi et al. would perhaps resulted in a camera in which a reset operation (e.g., step 16 of Toyofuku' Figure 24) is performed by setting the lens at a position corresponding to infinite distance, and one in which the user can depress an LCD switch in order to use it as a viewfinder (see Toyofuku, column 15, lines 62-64). Such combination, however, would not have suggested a controller for driving the taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range views *immediately* after recording of an image is performed, as claimed.

For at least these reasons, the rejection fails to establish a *prima facie* case. Hence, claim 10 is allowable.

The Office Action also includes a rejection of claim 17 under 35 U.S.C. § 103 as allegedly being unpatentable over the Toyofuku patent in view of the Isoguchi et al. patent. This rejection is respectfully traversed.

Claim 17 is directed to a display control method that comprises the steps of immediately after recording of an image, determining whether a display setting is set for permitting the display device to display an image or set for prohibiting the display device from displaying an image. Claim 17 further recites automatically driving a taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range

¹ While claim 11 is mentioned in this section of the final Office Action, it is believed that the Examiner is addressing the arguments on page 12 of the September 15, 2003 Amendment directed to claim 10.

views when it is determined that the display setting permits display of an image, and displaying an image taken through by the taking lens situated at the focus position.

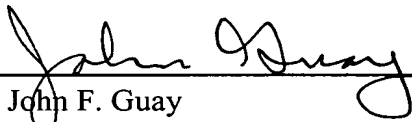
With respect to this claimed subject matter, the Examiner essentially asserts, at page 10 of the Office Action, that the Toyofuku patent teaches all the features of claim 10 except for a lens is driven to a focus position where in-focus condition is substantially obtained for distant to close-range views after recording of the image is performed. The Examiner then asserts that it would have been obvious from the teaching in Isoguchi et al. of driving a lens to an initial position after a photographing operation is completed to modify the camera of the Toyofuku patent to drive the lens to an initial position after recording an image so that it is reset and capable of quickly capturing another image. It is respectfully submitted, however, that Isoguchi et al. does not remedy the acknowledged shortcomings of Toyofuku. As pointed out above with respect to claim 10, the Isoguchi et al. patent does not teach or suggest automatically driving a taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range views. Moreover, the cited parts of the Isoguchi et al. patent do not mention displaying an image taken through the taking lens situated at the focus position, as claimed. In contrast, Isoguchi et al. discloses that after the lens 94 is returned to the initial position, the CPU 100 prepares for the next photographing cycle. (See column 23, lines 66-68.) As further pointed out above, in order to reduce power consumption, the Toyofuku patent only operates the LCD display in the photographic mode when the LCD switch 58 is *manually* operated. Hence, there is no apparent disclosure in the applied documents that would have suggested the claimed features of automatically driving a taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range views, and displaying an image taken through by the taking lens situated at the focus position.

For the above reasons, the proposed combination of Toyofuku and Isoguchi et al. does not teach or suggest the combination of each and every feature recited in claim 17. As such, the rejection fails to establish a *prima facie* case. Accordingly, the rejection of claim 17 is improper and should be withdrawn.

For all the foregoing reasons, Applicants respectfully request withdrawal of the rejections of the pending claims. Prompt allowance of the application is earnestly solicited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
John F. Guay
Registration No. 47,248

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

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